



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,495	04/24/2006	Nicolas Mermod	3024-119	1575
46002 7590 11/18/2011				
JOYCE VON NATZMER				
PIQUIGNOT + MYERS LLC				
200 Madison Avenue				
Suite 1901				
New York, NY 10016				
EXAMINER				
QIAN, CELINE X				
ART UNIT		PAPER NUMBER		
1636				
MAIL DATE		DELIVERY MODE		
11/18/2011		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/595,495

Applicant(s)

MERMOD ET AL.

Examiner

CELINE QIAN

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 November 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Celine X Qian /
Primary Examiner, Art Unit 1636

Continuation of 11, does NOT place the application in condition for allowance because: the arguments are not persuasive. Applicants request withdrawal of the finality of the office action mailed on 9/9/2011 on the basis that only the broadest claim was addressed, and the office action has left out the dependent claims and new claims. Applicants assert that the office does not mention in the rejection the melting temperature referenced in claim 72 or 123 or the DNA bending values. Applicants also assert that the office has not provided any analysis why claim 62 should be treated differently from claim 1 of the "written description training material" of March 2008. The above arguments have been fully considered and deemed unpersuasive. The Office action mailed on 9/9/2011 has addressed all pending claims including dependent claims and newly presented claims. With regard to the limitation directed to melting temperature and bending value, the examiner directs Applicant's attention to page 7, lines 15-23. Although the rejection did not specifically mention they are part of the limitation of claim 72 and 123, it nevertheless addressed such limitations from both claims, and there is no requirement according to MPEP to mention the claim number specifically. With regard to the argument directed to claim 62, Applicants are reminded that this claim, directed to a computer readable medium, is withdrawn from consideration based on the election made on 10/20/2008. The claim 1 of example 1 from the written description guideline does not apply to the instant case because it is directed to a new matter situation in which it deals with priority, original and amended claims. If Applicant meant comparing claim 65 to example 11 in the written description guideline, the analysis has been provided thoroughly in the rejection set forth in previous office action. The rejection has provided analysis to claimed nucleic acids having MAR activity claiming percent homology to SEQ ID NO: 25 following the written description guideline (see page 3-7), and concluded that the MAR sequences having 90% homology with SEQ ID NO: 25 have not been sufficiently described by the instant specification because art recognized structure function correlation does not present. Contrary to the allegation in the response filed on 11/9/2011, the examiner has addressed all the claims under examination. Therefore, the finality of the office action mailed on 9/9/2011 will not be withdrawn.